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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,058	12/22/1999	KIMBERLY JOYCE WELBORN		5713

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EXAMINER
NOBAHAR, ABDULHAKIM

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/470,058	Applicant(s) WELBORN ET AL.	
	Examiner Abdulhakim Nobahar	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6-7, 9, 12-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Venkatraman et al. (6,014,688) (hereinafter Venkatraman).

Regarding claim 1, Venkatraman discloses:

A computer system that sends an e-mail with an attachment to e-mail users (see, for example, column 1, lines 15-19 and column 4, lines 3-7) and creates a list of e-mail users that open the attachment. See, for example, column 5, lines 3-10, column 6, lines 10-15, column 8, lines 1-23, column 8, lines 32-42 and Fig. 15 where collecting and compiling the return receipt responses corresponds to the recited "creates a list of e-mail users that open the attachment".

Regarding claim 2, Venkatraman discloses:

The attachment displays a message to the user when the attachment is opened. See, for example, column 4, lines 3-12 and column 7, lines 6-22.

Regarding claims 6 and 12, Venkatraman discloses:

A means for sending an e-mail with an attachment to an e-mail address (see, for example, column 1, lines 15-19 and column 4, lines 3-7), and a means to send an e-mail to a specific email address when the attachment is opened (see, for example, column 2, lines 34-37, Fig. 16, 160 and column 8, lines 37-43).

Regarding claims 7 and 13, Venkatraman discloses:

The attachment displays a message to the user when the attachment is opened. See, for example, column 4, lines 3-12 and column 7, lines 6-22.

Regarding claims 9 and 15, Venkatraman discloses:

The specific e-mail address (in-box) gathers and creates a list of e-mail users (addresses) that opened the attachment (have sent it messages). See, for example, column 8, lines 24-42 and Fig. 15 where collecting and compiling the return receipt responses corresponds to the recited "creates a list of e-mail users that open the attachment".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. (6,014,688) (hereinafter Venkatraman) in view of Donoho et al. (6,256,664 B1) (hereinafter Donoho).

Regarding claims 3, 8 and 14, Venkatraman does not expressly disclose that an e-mail message is sent to the user who opens the attachment of an e-mail. Donoho (column 88, lines 13-35) teaches a method of broadcasting advisory messages to a plurality of information consumers. In this method the mail reader application located on the consumer computer sends a notifying message to advisory reader upon occurrence of an event corresponding to the recited "open the attachment". The advisory reader evaluates the advisories in an event pool upon receiving the notifying message and sends a relevant message(s) to the mail reader and the mail reader then displays the message(s) to the user who has opened the attachment.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the feature of sending (advisory or warning) message(s) to user who opens an e-mail attachment as taught in Donoho in the system of Venkatraman, because it would provide a mechanism to direct typical piece of information to consumers having a very special combination of circumstances (column 1, lines 33-35).

Claims 4, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. (6,014,688) (hereinafter Venkatraman) in view of Fischer (5,390,247).

Regarding claims 4, 10 and 16, Venkatraman does not expressly disclose that the e-mail attachment at the recipient computer transmit itself to other e-mail users. Fischer discloses a method for creating a traveling program that is capable of determining at least one next recipient and transmitting itself to that recipient(s) automatically. See, for example, abstract, column 5, lines 37-42 and column 7, lines 46-57.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the capability of transmitting itself to other recipients by a computer code as taught in Fischer in the system of Venkatraman, because it would provide a feature for the e-mail attachment to determine at least one next destination or recipient for transmitting itself (column 5, lines 1-7).

Claims 5, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. (6,014,688) (hereinafter Venkatraman) in view of Christie et al. (6,182,117 B1) (hereinafter Christie).

Regarding claims 5, 11 and 17, Venkatraman does not expressly disclose that the number of replication and transmission cycles is limited. Christie teaches a method

for replicating data between computer sites via e-mail (column 2, lines 32-36). Christie's method is capable of imposing limits on the flow of messages (column 15, lines 43-46) and controlling the number of messages in transient (column 6, lines 16-23 and column 18, lines 1-4). A replication agent (see, for example, column 3, lines 13-16) synchronizes the data at its site with the data stored at the other site(s) and further determines (see, for example, column 4, lines 22-29) which sites are to receive which objects. This indicates that there is a mechanism in the Christie's method that controls the number of replication of data.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the capability of controlling the number of replication of data as taught in Christie in the system of Venkatraman, because it would provide a feature for replication without real-time connections between replication sites (column 2, lines 55-58).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US patent application publication No. 2002/0178137 A1 to Hasegawa.

US patent No. 5,832,208 to Chen et al.

US patent No. 6,219,694 B1 to Lazaridis et al.

US patent No. 6,219,669 B1 to Haff et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Abdulhakim Nobahar
Examiner
Art Unit 2132

AN

August 21, 2003

GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100